

ESTTA Tracking number: **ESTTA186803**

Filing date: **01/15/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91177858
Party	Defendant Nordstrom, Inc.
Correspondence Address	WILLIAM O. FERRON, JR. SEED IP LAW GROUP PLLC 701 5TH AVE STE 5400 SEATTLE, WA 98104-7064 UNITED STATES BillF.docketing@SeedIP.com
Submission	Other Motions/Papers
Filer's Name	William O. Ferron, Jr.
Filer's e-mail	BillF.docketing@SeedIP.com, litcal@SeedIP.com
Signature	/William O. Ferron, Jr./
Date	01/15/2008
Attachments	DeclDurranceWithExhs1-2.pdf (39 pages)(515577 bytes) DeclDurrance-Exhs.3-13.pdf (34 pages)(591002 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

ZANELLA LTD.,)	
)	Opposition No. 91177858
Opposer,)	
)	Serial No. 77025247
v.)	
)	
NORDSTROM, INC.,)	
)	
Applicant.)	Attorney Docket No. 700043.80073

**DECLARATION OF NATHANIEL E. DURRANCE IN SUPPORT
OF APPLICANT'S MOTION FOR SUMMARY JUDGMENT AND
MOTION TO AMEND ANSWER TO ADD COUNTERCLAIM**

I, Nathaniel E. Durrance, hereby declare and state:

1. I am an attorney with the law firm of Seed Intellectual Property Law Group PLLC ("Seed IP"), which represents Applicant Nordstrom, Inc. ("Applicant" or "Nordstrom") in this opposition proceeding. I have reviewed and am familiar with the contents of Seed IP's files pertaining to this proceeding. The following facts are true of my own knowledge unless otherwise stated.

2. On September 26, 2007, counsel for Applicant served on Opposer's counsel, by U.S. first-class mail, a First Set of Requests for Admissions, a First Set of Interrogatories, and a First Set of Requests for Production of Documents. On November 20, 2007, pursuant to an

agreed extension of time to respond, Opposer served its written responses to these discovery requests and copies of documents responding to Applicant's requests for production. Opposer's written discovery responses and produced documents were received in the offices of Applicant's counsel on or about November 21, 2007.

3. Attached hereto as Exhibit 1 is a true and correct copy of Opposer's November 20, 2007 responses to Applicant's First Set of Requests for Admissions.

4. Attached hereto as Exhibit 2 is a true and correct copy of excerpts from Opposer's November 20, 2007 responses to Applicant's First Set of Interrogatories, consisting of the face sheet, the responses to Interrogatory Nos. 37 and 38, the signature page, verification page, and certificate of service.

5. Attached hereto as Exhibits 3 through 7, respectively, are true and correct copies of the following documents produced by Opposer on November 20, 2007 in response to Applicant's First Set of Requests for Production:

- (a) Application for registration of ZANELLA & Design dated April 11, 2000 (Application Serial No. 76021021), bearing Bates Nos. ZAN 397-399 (Exhibit 3);
- (b) U.S. Trademark Registration No. 1519894 bearing Bates No. ZAN 460 (Exhibit 4);
- (c) U.S. Trademark Registration No. 1527003 bearing Bates No. ZAN 472 (Exhibit 5);
- (d) "Affidavit of Use and Incontestability of a Trademark Under 15 U.S.C. Sections 8 and 15(1)" for U.S. Trademark Registration No. 1519894, bearing Bates No. ZAN 484-485 (Exhibit 6); and
- (e) "Affidavit of Use and Incontestability of a Trademark Under 15 U.S.C. Sections 8 and 15(1)" for U.S. Trademark Registration No. 1527003, bearing Bates No. ZAN 499-500 (Exhibit 7).

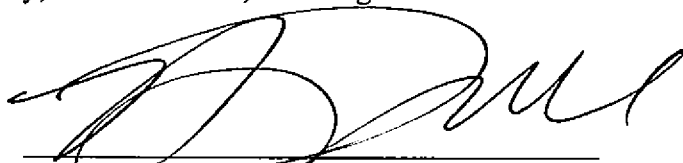
6. Following receipt of Opposer's discovery responses, Seed IP ordered partial file histories for a number of Opposer's cited trademark registrations. The last of the file histories were received in Seed IP's offices on December 28, 2007. Attached hereto as Exhibits 8 through 13, respectively, are true and correct copies of the following excerpts from those trademark file histories:

- (a) U.S. Trademark Application Serial No. 73662018 dated May 21, 1987 (Exhibit 8);
- (b) U.S. Trademark Application Serial No. 73662076 dated May 21, 1987 (Exhibit 9);
- (c) Response to Office Action and Amendment to Application dated July 3, 1995 in Serial No. 74548674 (Exhibit 10);
- (d) U.S. Trademark Registration No. 1990695 (Exhibit 11);
- (e) Response to Office Action and Amendment to Application dated July 3, 1995 in Serial No. 74548675 (Exhibit 12); and
- (f) U.S. Trademark Registration No. 1992385 (Exhibit 13).

7. On December 20, 2007, the parties filed a Consented Motion to extend the discovery and testimony periods, extending, inter alia, the close of discovery to May 1, 2008. The Board granted this motion in an Order dated January 3, 2008.

I declare under penalty of perjury under the laws of the United States of America that the above is true and correct.

DATED this 14th day of January, 2008 at Seattle, Washington.




Nathaniel E. Durrance

CERTIFICATE OF SERVICE

I, Annette Baca, hereby certify that the above **DECLARATION OF NATHANIEL E. DURRANCE IN SUPPORT OF APPLICANT'S MOTION FOR SUMMARY JUDGMENT AND MOTION TO AMEND ANSWER TO ADD COUNTERCLAIM** was served on Opposer's counsel by depositing same with the U.S. Postal Service, first-class postage prepaid, on January 15, 2008, addressed as follows:

Stuart E. Benson, Esq.
Michael H. Selter, Esq.
MANELLI DENISON & SELTER PLLC
2000 M Street, N.W., Suite 700
Washington, D.C. 20036



Annette Baca

EXHIBIT 1

THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ZANELLA LTD.,)
)
 Opposer)
)
 v.)
)
 NORDSTROM, INC.,)
)
 Applicant)
 (S/N 77/025,747))
)

Opposition No. 91177858

WDF, INC. AR
RECEIVED
NOV 21 2007
SEED INTELLECTUAL PROPERTY
LAW GROUP-LITIGATION
700048.80073

**OPPOSER ZANELLA LTD.'S RESPONSES TO APPLICANT NORDSTROM, INC.'S
FIRST SET OF REQUESTS FOR ADMISSIONS**

Pursuant to Fed. R. Civ. P. 36 and 37 C.F.R. § 2.120, Opposer Zanella, Ltd., by and through its counsel, hereby responds to Applicant's First Set of Requests for Admissions served on it by Applicant Nordstrom, Inc.

REQUESTS FOR ADMISSIONS

REQUEST NO.1:

Admit that "Zanella" is the surname of the founder of Opposer's predecessor.

RESPONSE:

Admitted.

REQUEST NO.2:

Admit that Opposer's largest selling goods are men's trousers.

RESPONSE:

Admitted.

REQUEST NO.3:

Admit that non-clearance, non-sale retail prices for Opposer's trousers for men start at \$249.00.

RESPONSE:

Opposer objects to Request No. 3 because it seeks information not in Opposer's possession or knowledge.

REQUEST NO.4:

Admit that non-clearance, non-sale retail prices for Opposer's pants for women start at \$295.00.

RESPONSE:

Opposer objects to Request No. 3 because it seeks information not in Opposer's possession or knowledge.

REQUEST NO.5:

Admit that Exhibit A is a copy of the U.S. Trademark Trial and Appeal Board decision in Opposition No. 91153249.

RESPONSE:

Admitted.

REQUEST NO.6:

Admit that Exhibit B is a copy of a Request to Amend Trademark Registration filed in connection with U.S. Trademark Registration No. 1519894 on behalf of Opposer.

RESPONSE:

Admitted.

REQUEST NO.7:

Admit that Exhibit C is a copy of Combined Declaration of Use and Incontestability under Sections 8 & 15 filed in connection with U.S. Trademark Registration No. 1992385 on behalf of Opposer.

RESPONSE:

Admitted.

REQUEST NO.8:

Admit that Exhibit D is a copy of Combined Declaration of Use and Incontestability under Sections 8 & 15 filed in connection with U.S. Trademark Registration No. 1990695 on

behalf of Opposer.

RESPONSE:

Admitted.

REQUEST NO.9:

Admit that Exhibit E is a copy of Combined Declaration of Use and Incontestability under Sections 8 & 15 filed in connection with U.S. Trademark Registration No. 2453062 on behalf of Opposer.

RESPONSE:

Admitted.

REQUEST NO. 10:

Admit that Opposer was a party in Opposition No. 91153249 before the U.S. Trademark Trial and Appeal Board and that Opposer asserted its Zanella Marks in opposition to registration of U.S. Trademark Application Serial No. 76292052.

RESPONSE:

Admitted.

REQUEST NO. 11:

Admit that the U.S. Trademark Trial and Appeal Board in Opposition No. 91153249 found that "Zanella" is the surname of the founder of Opposer's predecessor.

RESPONSE:

Denied. The document speaks for itself.

REQUEST NO. 12:

Admit that the U.S. Trademark Trial and Appeal Board in Opposition No. 91153249 found that Opposer's Zanella Marks have "some public recognition" that "is mainly conferred to the limited segment of high-end trousers, and little else."

RESPONSE:

Denied. The document speaks for itself.

REQUEST NO. 13:

Admit that the U.S. Trademark Trial and Appeal Board in Opposition No. 91153249 found that Opposer's Zanella Marks are not famous.

RESPONSE:

Denied. The document speaks for itself.

REQUEST NO. 14:

Admit that the U.S. Trademark Trial and Appeal Board in Opposition No. 91153249 found that Opposer's Zanella name enjoys only limited recognition.

RESPONSE:

Denied. The document speaks for itself.

REQUEST NO. 15:

Admit that the U.S. Trademark Trial and Appeal Board in Opposition No. 91153249 found that Opposer's Zanella Marks are not comparable to other designer marks such as Laura Ashley and Liz Claiborne, and that these other designer names are far better known than Zanella.

RESPONSE:

Denied. The document speaks for itself.

REQUEST NO. 16:

Admit that the U.S. Trademark Trial and Appeal Board in Opposition No. 91153249 found that Opposer is "a lesser known designer in a more limited clothing field, primarily known for men's trousers."

RESPONSE:

Denied. The document speaks for itself.

REQUEST NO. 17:

Admit that the U.S. Trademark Trial and Appeal Board in Opposition No. 91153249 found that "Opposer has never expanded its product line beyond upscale clothing made in Italy."

RESPONSE:

Denied. The document speaks for itself.

REQUEST NO. 18:

Admit that in Opposition No. 91153249 before the U.S. Trademark Trial and Appeal Board, Opposer's president, Armando Di Natale, testified that Opposer has never taken any steps to license its Zanella Mark.

RESPONSE:

Denied. His testimony speaks for itself.

REQUEST NO. 19:

Admit that the U.S. Trademark Trial and Appeal Board in Opposition No. 91153249 found that Opposer's Zanella "goods are marketed as high-end, upscale items, and are directed to affluent consumers."

RESPONSE:

Denied. The document speaks for itself.

REQUEST NO. 20:

Admit that the U.S. Trademark Trial and Appeal Board in Opposition No. 91153249 found that Opposer's Zanella "clothing is sold in high-end specialty stores and expensive

department stores.”

RESPONSE:

Denied. The document speaks for itself.

REQUEST NO. 21:

Admit that consumers of Opposer’s goods sold under its Zanella Marks are sophisticated and discriminating consumers.

RESPONSE:

Denied.

REQUEST NO. 22:

Admit that Opposer is aware of no actual confusion among the consuming public between Opposer’s Zanella Mark and Applicant’s Zella Mark.

RESPONSE:

Admitted.

REQUEST NO. 23:

Admit that scarves have never been distributed in connection with Opposer’s Zanella Marks in the United States.

RESPONSE:

Denied.

REQUEST NO. 24:

Admit that hats have never been distributed in connection with Opposer's Zanella Marks in the United States.

RESPONSE:

Admitted.

REQUEST NO. 25:

Admit that swimwear has never been distributed in connection with Opposer's Zanella Marks in the United States.

RESPONSE:

Admitted.

REQUEST NO. 26:

Admit that socks have never been distributed in connection with Opposer's Zanella Marks in the United States.

RESPONSE:

Admitted

REQUEST NO. 27:

Admit that underwear has never been distributed in connection with Opposer's Zanella Marks in the United States.

RESPONSE:

Admitted.

REQUEST NO. 28:

Admit that mantles have never been distributed in connection with Opposer's Zanella Marks in the United States.

RESPONSE:

Admitted.

REQUEST NO. 29:

Admit that waistcoats have never been distributed in connection with Opposer's Zanella Marks in the United States.

RESPONSE:

Admitted.

REQUEST NO. 30:

Admit that stockings have never been distributed in connection with Opposer's Zanella

Marks in the United States.

RESPONSE:

Admitted.

REQUEST NO. 31:

Admit that ties have never been distributed in connection with Opposer's Zanella Marks in the United States.

RESPONSE:

Admitted.

REQUEST NO. 32:

Admit that men's blouses have never been distributed in connection with Opposer's Zanella Mark in the United States.

RESPONSE:

Denied.

REQUEST NO. 33:

Admit that Opposer's Zanella Marks were not used on or in connection with men's mantles distributed in the United States prior to May 21, 1987.

RESPONSE:

Admitted.

REQUEST NO. 34:

Admit that Opposer's Zanella Marks were not used on or in connection with men's blouses distributed in the United States prior to May 21, 1987.

RESPONSE:

Admitted.

REQUEST NO. 35:

Admit that Opposer's Zanella Marks were not used on or in connection with men's waistcoats distributed in the United States prior to May 21, 1987.

RESPONSE:

Admitted.

REQUEST NO. 36:

Admit that Opposer's Zanella Marks were not used on or in connection with men's socks distributed in the United States prior to May 21, 1987.

RESPONSE:

Admitted.

REQUEST NO. 37:

Admit that Opposer's Zanella Marks were not used on or in connection with men's stockings distributed in the United States prior to May 21, 1987.

RESPONSE:

Admitted.

REQUEST NO. 38:

Admit that Opposer's Zanella Marks were not used on or in connection with men's ties distributed in the United States prior to May 21, 1987.

RESPONSE:

Admitted.

REQUEST NO. 39:

Admit that Opposer's Zanella Marks were not used on or in connection with men's scarves distributed in the United States prior to May 21, 1987.

RESPONSE:

Admitted.

REQUEST NO. 40:

Admit that Opposer's Zanella Marks were not used on or in connection with men's hats

distributed in the United States prior to May 21, 1987.

RESPONSE:

Admitted.

REQUEST NO. 41:

Admit that Opposer's Zanella Marks were not used on or in connection with men's swimwear distributed in the United States prior to May 21, 1987.

RESPONSE:

Admitted.

REQUEST NO. 42:

Admit that Opposer's Zanella Marks were not used on or in connection with men's underwear distributed in the United States prior to May 21, 1987.

RESPONSE:

Admitted.

REQUEST NO. 43:

Admit that Opposer's Zanella Marks were not used on or in connection with women's scarves distributed in the United States prior to July 13, 1994.

RESPONSE:

Admitted.

REQUEST NO. 44:

Admit that Opposer's Zanella Marks were not used on or in connection with women's hats distributed in the United States prior to July 13, 1994.

RESPONSE:

Admitted.

REQUEST NO. 45:

Admit that Opposer's Zanella Marks were not used on or in connection with women's swimwear distributed in the United States prior to July 13, 1994.

RESPONSE:

Admitted.

REQUEST NO. 46:

Admit that Opposer's Zanella Marks were not used on or in connection with women's socks distributed in the United States prior to July 13, 1994.

RESPONSE:

Admitted.

REQUEST NO. 47:

Admit that Opposer's Zanella Marks were not used on or in connection with women's underwear distributed in the United States prior to July 13, 1994.

RESPONSE:

Admitted.

REQUEST NO. 48:

Admit that Opposer's Zanella Marks were not used on or in connection with scarves distributed in the United States prior to April 11, 2000.

RESPONSE:

Admitted.

REQUEST NO. 49:

Admit that Opposer's Zanella Marks were not used on or in connection with hats distributed in the United States prior to April 11, 2000.

RESPONSE:

Admitted.

REQUEST NO. 50:

Admit that Opposer's Zanella Marks were not used on or in connection with swimwear

distributed in the United States prior to April 11, 2000.

RESPONSE:

Admitted.

REQUEST NO. 51:

Admit that Opposer's Zanella Marks were not used on or in connection with socks distributed in the United States prior to April 11, 2000.

RESPONSE:

Admitted.

REQUEST NO. 52:

Admit that Opposer's Zanella Marks were not used on or in connection with underwear distributed in the United States prior to April 11, 2000.

RESPONSE:

Admitted.

REQUEST NO. 53:

Admit that Opposer's Zanella Marks were not used on or in connection with mantles distributed in the United States prior to April 11, 2000.

RESPONSE:

Admitted.

REQUEST NO. 54:

Admit that Opposer's Zanella Marks were not used on or in connection with waistcoats distributed in the United States prior to April 11, 2000.

RESPONSE:

Admitted.

REQUEST NO. 55:

Admit that Opposer's Zanella Marks were not used on or in connection with stockings distributed in the United States prior to April 11, 2000.

RESPONSE:

Admitted.

REQUEST NO. 56:

Admit that Opposer's Zanella Marks were not used on or in connection with ties distributed in the United States prior to April 11, 2000.

RESPONSE:

Admitted.

REQUEST NO. 57:

Admit that at the time Opposer submitted its Section 8 Declaration of Use to the United States Patent and Trademark Office for U.S. Trademark Registration No. 1527003, the Zanella Mark was not being used on or in connection with men's mantles distributed in the United States.

RESPONSE:

Admitted.

REQUEST NO. 58:

Admit that at the time Opposer submitted its Section 8 Declaration of Use to the United States Patent and Trademark Office for U.S. Trademark Registration No. 1527003, the Zanella Mark was not being used on or in connection with men's blouses distributed in the United States.

RESPONSE:

Admitted.

REQUEST NO. 59:

Admit that at the time Opposer submitted its Section 8 Declaration of Use to the United States Patent and Trademark Office for U.S. Trademark Registration No. 1527003, the Zanella Mark was not being used on or in connection with men's waistcoats distributed in the United States.

RESPONSE:

Admitted.

REQUEST NO. 60:

Admit that at the time Opposer submitted its Section 8 Declaration of Use to the United States Patent and Trademark Office for U.S. Trademark Registration No. 1527003, the Zanella Mark was not being used on or in connection with men's socks distributed in the United States.

RESPONSE:

Admitted.

REQUEST NO. 61:

Admit that at the time Opposer submitted its Section 8 Declaration of Use to the United States Patent and Trademark Office for U.S. Trademark Registration No. 1527003, the Zanella Mark was not being used on or in connection with men's stockings distributed in the United States.

RESPONSE:

Admitted.

REQUEST NO. 62:

Admit that at the time Opposer submitted its Section 8 Declaration of Use to the United States Patent and Trademark Office for U.S. Trademark Registration No. 1527003, the Zanella

Mark was not being used on or in connection with men's ties distributed in the United States.

RESPONSE:

Admitted.

REQUEST NO. 63:

Admit that at the time Opposer submitted its Section 8 Declaration of Use to the United States Patent and Trademark Office for U.S. Trademark Registration No. 1527003, the Zanella Mark was not being used on or in connection with men's scarves distributed in the United States.

RESPONSE:

Admitted.

REQUEST NO. 64:

Admit that at the time Opposer submitted its Section 8 Declaration of Use to the United States Patent and Trademark Office for U.S. Trademark Registration No. 1527003, the Zanella Mark was not being used on or in connection with men's hats distributed in the United States.

RESPONSE:

Admitted.

REQUEST NO. 65:

Admit that at the time Opposer submitted its Section 8 Declaration of Use to the United

States Patent and Trademark Office for U.S. Trademark Registration No. 1527003, the Zanella Mark was not being used on or in connection with men's swimwear distributed in the United States.

RESPONSE:

Admitted.

REQUEST NO. 66:

Admit that at the time Opposer submitted its Section 8 Declaration of Use to the United States Patent and Trademark Office for U.S. Trademark Registration No. 1527003, the Zanella Mark was not being used on or in connection with men's underwear distributed in the United States.

RESPONSE:

Admitted.

REQUEST NO. 67:

Admit that at the time Opposer submitted its Section 8 Declaration of Use to the United States Patent and Trademark Office for U.S. Trademark Registration No. 1519894, the Zanella Mark was not being used on or in connection with men's mantles distributed in the United States.

RESPONSE:

Admitted.

REQUEST NO. 68:

Admit that at the time Opposer submitted its Section 8 Declaration of Use to the United States Patent and Trademark Office for U.S. Trademark Registration No. 1519894, the Zanella Mark was not being used on or in connection with men's blouses distributed in the United States.

RESPONSE:

Admitted.

REQUEST NO. 69:

Admit that at the time Opposer submitted its Section 8 Declaration of Use to the United States Patent and Trademark Office for U.S. Trademark Registration No. 1519894, the Zanella Mark was not being used on or in connection with men's waistcoats distributed in the United States.

RESPONSE:

Admitted.

REQUEST NO. 70:

Admit that at the time Opposer submitted its Section 8 Declaration of Use to the United States Patent and Trademark Office for U.S. Trademark Registration No.

1519894, the Zanella Mark was not being used on or in connection with men's socks distributed in the United States.

RESPONSE:

Admitted.

REQUEST NO. 71:

Admit that at the time Opposer submitted its Section 8 Declaration of Use to the United States Patent and Trademark Office for U.S. Trademark Registration No. 1519894, the Zanella Mark was not being used on or in connection with men's stockings distributed in the United States.

RESPONSE:

Admitted.

REQUEST NO. 72:

Admit that at the time Opposer submitted its Section 8 Declaration of Use to the United States Patent and Trademark Office for U.S. Trademark Registration No. 1519894, the Zanella Mark was not being used on or in connection with men's ties distributed in the United States.

RESPONSE:

Admitted.

REQUEST NO. 73:

Admit that at the time Opposer submitted its Section 8 Declaration of Use to the United States Patent and Trademark Office for U.S. Trademark Registration No. 1519894, the Zanella Mark was not being used on or in connection with men's scarves distributed in the United States.

RESPONSE:

Admitted.

REQUEST NO. 74:

Admit that at the time Opposer submitted its Section 8 Declaration of Use to the United States Patent and Trademark Office for U.S. Trademark Registration No. 1519894, the Zanella Mark was not being used on or in connection with men's hats distributed in the United States.

RESPONSE:

Admitted.

REQUEST NO. 75:

Admit that at the time Opposer submitted its Section 8 Declaration of Use to the United States Patent and Trademark Office for U.S. Trademark Registration No. 1519894, the Zanella Mark was not being used on or in connection with men's swimwear distributed in the United States.

RESPONSE:

Admitted.

REQUEST NO. 76:

Admit that at the time Opposer submitted its Section 8 Declaration of Use to the United States Patent and Trademark Office for U.S. Trademark Registration No. 1519894, the Zanella Mark was not being used on or in connection with men's underwear distributed in the United States.

RESPONSE:

Admitted.

Dated: November 20, 2007.



Stuart E. Benson
Michael H. Selter
MANELLI DENISON & SELTER PLLC
2000 M Street, N.W.
Suite 700
Washington, D.C. 20036
202.261.1000

Attorneys for Opposer Zanella Ltd.

CERTIFICATE OF SERVICE

I, Stuart E. Benson, hereby certify that on this 20th day of November, 2007, I caused a copy of the foregoing OPPOSER ZANELLA LTD.'S RESPONSES TO APPLICANT NORDSTROM, INC.'S FIRST SET OF REQUESTS FOR ADMISSIONS to be served on counsel for Applicant by overnight courier, addressed as follows:

William O. Ferron, Jr., Esq.
SEED IP Law Group PLLC
701 Fifth Avenue, Suite 5400
Seattle, Washington 98104



Stuart E. Benson

EXHIBIT 2

THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

WDS, WED, AB
RECEIVED

NOV 21 2007

SEED INTELLECTUAL PROPERTY
LAW GROUP-LITIGATION

700043-80073

Opposition No. 91177858

ZANELLA LTD.,)
)
Opposer)
)
v.)
)
NORDSTROM, INC.,)
)
Applicant)
(S/N 77/025,747))
)

**OPPOSER ZANELLA LTD.'S RESPONSES TO APPLICANT NORDSTROM, INC.'S
FIRST SET OF INTERROGATORIES**

Pursuant to Fed. R. Civ. P. 33 and 37 C.F.R. § 2.120, by and through its counsel, Opposer Zanella, Ltd. ("Opposer" or "Zanella") hereby responds to the First Set of Interrogatories served on it by Applicant Nordstrom, Inc. ("Applicant" or "Nordstrom").

GENERAL OBJECTIONS

1. Opposer objects to Applicant's Interrogatories insofar as they seek to obtain information that is not relevant or material to the claims or defenses of either party and is not reasonably calculated to lead to the discovery of admissible evidence.
2. Opposer objects to those Interrogatories that are duplicative or cumulative or as to which information may be obtained from another source that is more convenient, less burdensome and less expensive.
3. Opposer objects to Applicant's Interrogatories to the extent they seek privileged

INTERROGATORY NO. 36:

For each of Opposer's U.S. Trademark Registrations for its Zanella Marks, including U.S. Reg. Nos. 1519894, 1992385, 1990695, and 2453062, state whether the goods deleted from each of Opposer's U.S. Trademark Registrations were being used in conjunction with the corresponding Zanella Mark in the United States as of:

- (a) the date Opposer filed the underlying U.S. Trademark Application; and
- (b) the date Opposer filed declarations claiming the Zanella Mark was in use for those goods.

RESPONSE:

Opposer objects to Interrogatory No. 36 as being vague as to the meaning of Opposer's goods being "used." Subject to this objection, with respect to the registrations named in the interrogatory, Opposer's use of its Zanella mark on goods identified in the registrations can be found in the documents provided in response to Applicant's Document Request No. 1. To Opposer's knowledge, its Zanella mark was not being used on the goods deleted from these registrations (a) as of the dates of filing the applications for these registrations or (b) as of the dates of filing the declarations of use of the marks.

INTERROGATORY NO. 37:

State whether Opposer's Zanella Mark found in U.S. Trademark Registration No. 1519894 had been used on or in connection with all of the goods deleted from Opposer's U.S. Trademark Registration No. 1519894 (including men's mantles, blouses, waistcoats, socks, stockings, ties, scarves, hats, swimwear, and underwear) as of:

(a) the date Opposer filed the underlying U.S. Trademark Application Serial No.

73662018;

(b) the date Opposer filed the declaration in connection with U.S. Trademark Application

Serial No. 73662018 claiming the Zanella Mark was in use for those goods; and

(c) the date Opposer filed a Section 8 Declaration of Use in connection with U.S.

Trademark Registration No. 1519894 claiming the Zanella Mark was in use for those goods.

RESPONSE:

To Opposer's knowledge, its Zanella mark was not being used on the goods deleted from this registration (a) as of the dates of filing the applications for these registrations or (b) as of the dates of filing the declarations of use of the mark.

INTERROGATORY NO. 38:

State whether Opposer's Zanella Mark found in U.S. Trademark Registration No. 1527003 had been used on men's mantles, blouses, waistcoats, socks, stockings, ties, scarves, hats, swimwear, or underwear, as of:

(a) the date Opposer filed the underlying U.S. Trademark Application Serial No.

73662076;

(b) the date Opposer filed the declaration in connection with U.S. Trademark Application

Serial No. 73662076 claiming the Zanella Mark was in use for those goods; and

(c) the date Opposer filed a Section 8 Declaration of Use in connection with U.S.

Trademark Registration No. 1527003 claiming the Zanella Mark was in use for those

goods.

RESPONSE:

To Opposer's knowledge, its Zanella mark was not being used on the goods deleted from this registration (a) as of the dates of filing the applications for these registrations or (b) as of the dates of filing the declarations of use of the mark.

Signed as to objections.

Dated: November 20, 2007

A handwritten signature in black ink, appearing to read "Stuart E. Benson", written over a horizontal line.

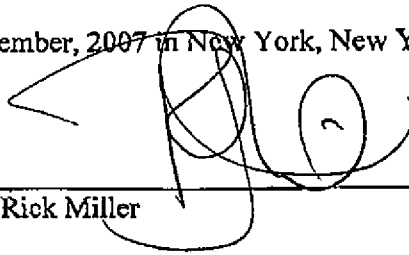
Stuart E. Benson
Michael H. Selter
MANELLI DENISON & SELTER PLLC
2000 M Street, N.W.
Suite 700
Washington, D.C. 20036
202.261.1000

Attorneys for Opposer Zanella Ltd.

VERIFICATION

I declare under the penalty of perjury of the laws of the United States of America that the foregoing answers have been prepared from information and records supplied by Zanella Ltd., that I believe that such information and records to be reliable and that on that basis I believe that to the best of my knowledge the foregoing answers are true and correct.

Executed this 19th day of November, 2007 in New York, New York.



Rick Miller

CERTIFICATE OF SERVICE

I, Stuart E. Benson, hereby certify that on this 20th day of November, 2007, I caused a copy of the foregoing OPPOSER ZANELLA LTD.'S RESPONSES TO APPLICANT NORDSTROM, INC.'S FIRST SET OF INTERROGATORIES to be served on counsel for Applicant by overnight courier, addressed as follows:

William O. Ferron, Jr., Esq.
SEED IP Law Group PLLC
701 Fifth Avenue, Suite 5400
Seattle, Washington 98104

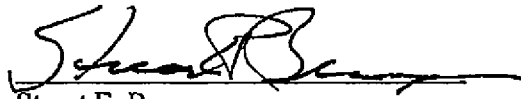

Stuart E. Benson

EXHIBIT 3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
APPLICATION FOR TRADEMARK REGISTRATION UNDER SECTION 1(a)

Mark: ZANELLA & Design
Int. Class: 25
Applicant: Zanella Ltd.

TO THE ASSISTANT COMMISSIONER FOR TRADEMARKS:

Applicant, ZANELLA LTD., is a corporation organized and existing under the laws of Delaware with its principal place of business at:

681 Fifth Avenue
New York, New York 10022

The above-identified applicant has adopted and is using the mark shown in the accompanying drawing for the following goods: Women's and men's clothing, namely, shorts, skirts, blouses, pants, jackets, coats, vests, scarves, hats, swimwear, raincoats, socks, underwear, mantels, shirts, waistcoats, trousers, stockings and ties and requests that said mark be registered in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946.

The trademark was first used in connection with the services at least as early January 1993; was first used in commerce between the United States and Italy in January 1993; and is now in use in such commerce.

Applicant is the owner of Registration Nos. 1,992,385 for "ZANELLA & Design", 1,519,584 for "ZANELLA", 1,990,695 ("ZANELLA") and 1,527,003 for "ZANELLA & Design."

A specimen showing the mark as actually used is presented herewith.

ZAN 00397

EXHIBIT 3

POWER OF ATTORNEY

Applicant hereby appoints Stuart E. Benson and Mary Boney Denison, attorneys at law, Farkas & Manelli, PLLC, 2000 M Street, N.W., Washington, D.C. 20036, to prosecute this application to register, to transact all business in the Patent and Trademark Office in connection with it, and to receive the certificate of registration. Please address all correspondence to:

Stuart E. Benson
Farkas & Manelli PLLC
1233 20th street, N.W., Suite 700
Washington, D.C. 20036
(202) 261.1000

DECLARATION

Armando Di Natale, being duly warned that wilful false statements and the like are punishable by fine or imprisonment or both (18 U.S.C. § 1001) and may jeopardize the validity of this application or any registration resulting from it, declares:


I am the President of the applicant corporation and am authorized to execute this application on its behalf. I believe the applicant is the owner of the mark sought to be registered and to the best of our knowledge and belief, no other person, firm, corporation or association has the right to use said mark in commerce, either in the identical form or in such near resemblance thereto as may be likely, when applied to the goods or services of such other person, to cause confusion, or to cause mistake, or to deceive. All statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true.

ZAN 00398

Dated: April 11, 2000

Respectfully submitted,

ZANELLA LTD.

By: 
Armando Di Natale
President

ZAN 00399

EXHIBIT 4

Int. Cl.: 25

Prior U.S. Cl.: 39

United States Patent and Trademark Office

Reg. No. 1,519,894

Registered Jan. 10, 1989

**TRADEMARK
PRINCIPAL REGISTER**

ZANELLA

FRATELLI ZANELLA S.P.A. (ITALY CORPORATION)
VIA CAPOVILLA 23/25
CALDOGNO (VICENZA), ITALY

FOR: MEN'S WEARING APPAREL, NAMELY
RAINCOATS, MANTLES, JACKETS, SHIRTS,
BLOUSES, WAISTCOATS, TROUSERS, PANTS,
SOCKS, STOCKINGS, TIES, SCARVES, HATS,
SWIMWEAR, VESTS AND UNDERWEAR, IN
CLASS 25 (U.S. CL. 39).

FIRST USE 2-0-1961; IN COMMERCE
5-0-1975.

OWNER OF U.S. REG. NOS. 1,236,427, 1,259,477
AND OTHERS.

SEC. 2(F).

SER. NO. 662,018, FILED 5-21-1987.

MARIA SOLOMON, EXAMINING ATTORNEY

ZAN 00460

EXHIBIT 4

EXHIBIT 5

Int. Cl.: 25

Prior U.S. Cl.: 39

United States Patent and Trademark Office

Reg. No. 1,527,003

Registered Feb. 28, 1989

**TRADEMARK
PRINCIPAL REGISTER**

Zanella

FRATELLI ZANELLA S.P.A. (ITALY CORPORATION)
VIA CAPOVILLA 23/25
CALDOGNO, ITALY

FOR: MEN'S WEARING APPAREL, NAMELY
RAINCOATS, MANTELS, JACKETS, SHIRTS,
BLOUSES, WAISTCOATS, TROUSERS, PANTS,
SOCKS, STOCKINGS, TIES, SCARVES, HATS,
SWIMWEAR, VESTS AND UNDERWEAR, IN
CLASS 25 (U.S. CL. 39).

FIRST USE 1-1-1987; IN COMMERCE
1-1-1987.

OWNER OF U.S. REG. NOS. 1,236,427, 1,259,477
AND OTHERS.

SEC. 2(F).

SER. NO. 662,076, FILED 5-21-1987.

MARIA SOLOMON, EXAMINING ATTORNEY

ZAN 00472

EXHIBIT 5

EXHIBIT 6



AFFIDAVIT OF USE AND INCONTESTABILITY
OF A TRADEMARK
UNDER 15 USC SECTIONS 8 AND 15(1)

#10

Mark: ZANELLA
Registration No.: 1,519,894
Class: International 25
Prior U.S.: 39

TO THE ASSISTANT COMMISSIONER FOR TRADEMARKS:

Ricky R. Miller, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this document, declares he is Vice President-Finance of Zanella, Ltd., the authorized representative of Zanella, S.p.A. (see attached copy of Power of Attorney from the Trustee of Zanella, S.p.A. to Zanella, Ltd.), an Italian corporation and owner of the above identified registration issued January 10, 1989, as shown by records in the Patent and Trademark Office;

That the mark shown therein has been in continuous use in commerce regulated by the United States for five consecutive years from the date of the registration to the present, on or in connection with all of the goods stated in the registration.

That said mark is still in use in interstate commerce and commerce between the United States and a foreign country, as evidenced by the attached specimen and that there has been no final decision adverse to the claim of ownership of Zanella S.p.A. of such mark for such goods, or to registrant's right to register the same or to keep the same on the register; that there is no proceeding involving said rights pending and not disposed of either in the Patent and Trademark Office or in the courts; and that all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

That, as Vice President-Finance of Zanella, Ltd., the authorized representative of Zanella, S.p.A., the undersigned is charged with overall responsibility for the marks owned by Zanella, S.p.A. and Zanella, Ltd., which are used on ZANELLA products, the sales of which have been approximately \$31,000,000 during the past year. He is personally ultimately responsible for the quality control and sales of the goods bearing the ZANELLA marks which are sold in approximately 500 stores in the United States. Further that he personally oversees the advertising for all the ZANELLA products. That the above information is provided of the undersigned's own personal knowledge.

ZAN 00484

EXHIBIT 6

POWER OF ATTORNEY

CD Registrant hereby appoints: L. Janá Sigars, Esq., of Holtzman, Krinzman, Equels & Furia, 2601 South Bayshore Drive, Miami, Florida 33133, a member of the Bar of the State of Florida, to act as its attorney, to receive any correspondence relating to this registration, to transact all business in the Patent and Trademark Office in connection therewith, upon whom notice or process in proceedings affecting the mark may be served.

DESIGNATION OF DOMESTIC REPRESENTATIVE

DR L. Janá Sigars, Esq., of Holtzman, Krinzman, Equels & Furia, 2601 South Bayshore Drive, Miami, Florida 33133 is hereby designated Registrant's representative upon whom notice or process in proceedings affecting the mark may be served.

ZANELLA S.p.A.

Dated: 8/25/95

By: 

Ricky R. Miller, a/k/a Richard Miller
Vice President-Finance
Zanella, Ltd.
Authorized Representative

CERTIFICATE OF EXPRESS MAIL

Express Mail label number: IB 54363439905

Date of deposit: August 31, 1995

I hereby certify that Registrant's Response to Renewal Examiner's correspondence and Amended Affidavit of Use and Incontestability of a Trademark Under 15 USC Sections 8 & 15(1) for ZANELLA is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202.

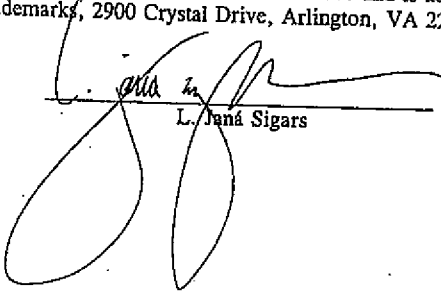
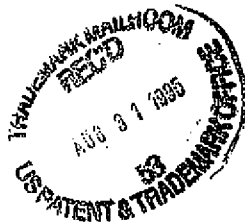

L. Janá Sigars

EXHIBIT 7



AFFIDAVIT OF USE AND INCONTESTABILITY
OF A TRADEMARK
UNDER 15 USC SECTIONS 8 AND 15(1)

Mark: ZANELLA and DESIGN

Registration No.: 1,527,003

Class: International 25
Prior U.S. 39

TO THE ASSISTANT COMMISSIONER FOR TRADEMARKS:

Ricky R. Miller, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this document, declares he is Vice President-Finance of Zanella, Ltd., the authorized representative of Zanella, S.p.A. (see attached copy of Power of Attorney from the Trustee of Zanella, S.p.A. to Zanella, Ltd.), an Italian corporation and owner of the above identified registration issued February 28, 1989, as shown by records in the Patent and Trademark Office;

That the mark shown therein has been in continuous use in commerce regulated by the United States for five consecutive years from the date of the registration to the present, on or in connection with all of the goods stated in the registration.

That said mark is still in use in interstate commerce and commerce between the United States and a foreign country, as evidenced by the attached specimen and that there has been no final decision adverse to the claim of ownership of Zanella S.p.A. of such mark for such goods, or to registrant's right to register the same or to keep the same on the register; that there is no proceeding involving said rights pending and not disposed of either in the Patent and Trademark Office or in the courts; and that all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

That, as Vice President-Finance of Zanella, Ltd., the authorized representative of Zanella, S.p.A., the undersigned is charged with overall responsibility for the marks owned by Zanella, S.p.A. and Zanella, Ltd., which are used on ZANELLA products, the sales of which have been approximately \$31,000,000 during the past year. He is personally ultimately responsible for the quality control and sales of the goods bearing the ZANELLA marks which are sold in approximately 500 stores in the United States. Further that he personally oversees the advertising for all the ZANELLA products. That the above information is provided of the undersigned's own personal knowledge.

ZAN 00499

EXHIBIT 7

POWER OF ATTORNEY

Registrant hereby appoints: L. Janá Sigars, Esq., of Holtzman, Krinzman, Equels & Furia, 2601 South Bayshore Drive, Miami, Florida 33133, a member of the Bar of the State of Florida, to act as its attorney, to receive any correspondence relating to this registration, to transact all business in the Patent and Trademark Office in connection therewith, upon whom notice or process in proceedings affecting the mark may be served.

DESIGNATION OF DOMESTIC REPRESENTATIVE

L. Janá Sigars, Esq., of Holtzman, Krinzman, Equels & Furia, 2601 South Bayshore Drive, Miami, Florida 33133 is hereby designated Registrant's representative upon whom notice or process in proceedings affecting the mark may be served.

ZANELLA S.p.A.

Dated: 8/20/95

By: 

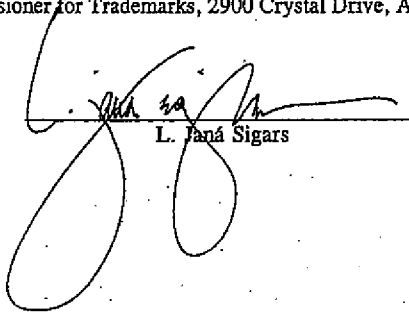
Ricky R. Miller, a/k/a Richard Miller
Vice President-Finance
Zanella, Ltd.
Authorized Representative

CERTIFICATE OF EXPRESS MAIL

Express Mail label number: IB 543633794 US

Date of deposit: August 31, 1995

I hereby certify that Registrant's Response to Renewal Examiner's correspondence and Amended Affidavit of Use and Incontestability of a Trademark Under 15 USC Sections 8 & 15(1) for ZANELLA and DESIGN is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202.


L. Janá Sigars

WFWIN-27200

ZAN 00500

EXHIBIT 8



00-00 3861 TM
3862018

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION FOR TRADEMARK REGISTRATION

Mark: ZANELLA

Class No.: International Class No. 25

TO THE COMMISSIONER OF PATENTS
AND TRADEMARKS:

F4
03
ITX

F3
ITX
Fratelli Zanella S.p.A.
Via Capovilla 23/25
36030 Caldogno (Vicenza), Italy

F3
035

The above-entitled applicant, a corporation duly organized and existing under the laws of Italy, has adopted and is using the trademark shown in the accompanying drawing for ⁰³⁵men's wearing apparel, namely raincoats, mantles, jackets, shirts, blouses, waistcoats, trousers, pants, socks, stockings, ties, scarves, hats, swimwear, vests and underwear, in International Class 25. Applicant requests that said mark be registered in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946.

F4

The trademark was first used on the goods in February 1961; it was first used in United States commerce in May 1975; and it is now in use in such commerce.

A stylized version of the mark was registered by applicant under Registration No. 1,257,646 dated November 15, 1983. Said registration is now in full force and effect.

F4

The mark is used by applying it to the goods, tags and labels affixed to the goods, containers for the goods, advertisements, other promotional materials used to advertise applicant's goods and other means customary in the trade. Five

- 2 -

specimens showing the mark as actually used are presented herewith.

POWER OF ATTORNEY

The undersigned hereby appoints GRAHAM & JAMES, 1050 17th Street, N.W., Washington, D.C. 20036, a law firm all members of which office are members of the Bar of the District of Columbia, to file this Application and to transact all business in the United States Patent and Trademark Office in connection therewith. F6
DC

APPOINTMENT OF DOMESTIC REPRESENTATIVE

GRAHAM & JAMES, whose postal address is 1050 17th Street, N.W., Washington, D.C. 20036, is hereby designated as Applicant's representative upon whom notices of process in proceedings affecting the mark may be served. M7

DECLARATION

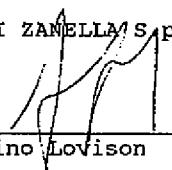
Landino Lovison, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any registration resulting therefrom, declares that: he is Managing Director of the Applicant, Fratelli Zanella S.p.A., and is authorized to execute this instrument as an officer of and on behalf of said Applicant; he believes said Applicant to be the owner of the trademark sought to be registered; to the best of his knowledge and belief, no other person, firm, corporation or association has

- 3 -

the right to use said mark in commerce, either in the identical form or in such near resemblance thereto as to be likely, when applied to the goods of such other person, to cause confusion or to cause mistake or to deceive; the facts set forth in this Application are true; all statements made of his knowledge are true; and all statements made on information and belief are believed to be true.

FRATELLI ZANELLA S.p.A.

Dated: May 21, 19 87

By: 
Landino Lovison

Its: Managing Director

EXHIBIT 9

200.00 301 Tm



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE 662076

APPLICATION FOR TRADEMARK REGISTRATION

Mark: ZANELLA with design

Class No.: International Class No. 25

TO THE COMMISSIONER OF PATENTS
AND TRADEMARKS:

F1
(03)
ITX

Fratelli Zanella S.p.A.
Via Capovilla 23/25
36030 Caldogno (Vicenza), Italy

F3
ITX

F3
025

The above-entitled applicant, a corporation duly organized and existing under the laws of Italy, has adopted and is using the trademark shown in the accompanying drawing for ⁰²⁵men's wearing apparel, namely raincoats, mant~~es~~^{les}, jackets, shirts, blouses, waistcoats, trousers, pants, socks, stockings, ties, scarves, hats, swimwear, vests and underwear, in International Class 25. Applicant requests that said mark be registered in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 ^{under section 2(f)}.

PERA

The trademark was first used on the goods on January 1, 1987; it was first used in United States commerce on January 1, 1987; and it is now in use in such commerce.

A stylized version of the mark was registered by applicant under Registration No. 1,257,646 dated November 15, 1983. Said registration is now in full force and effect.

IND A

The mark is used by applying it to the goods, tags and labels affixed to the goods, containers for the goods, advertisements, other promotional materials used to advertise applicant's goods and other means customary in the trade. Five

EXHIBIT 9

- 2 -

specimens showing the mark as actually used are presented herewith.

POWER OF ATTORNEY

FG
DC The undersigned hereby appoints GRAHAM & JAMES // 1050 17th Street, N.W., Washington, D.C. 20036, / a law firm all members of which office are members of the Bar of the District of Columbia, to file this Application and to transact all business in the United States Patent and Trademark Office in connection therewith.

APPOINTMENT OF DOMESTIC REPRESENTATIVE

Fy GRAHAM & JAMES, / whose postal address is / 1050 17th Street, N.W., Washington, D.C. 20036, / is hereby designated as Applicant's representative upon whom notices of process in proceedings affecting the mark may be served.

DECLARATION

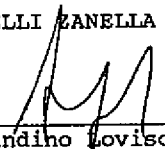
Landino Lovison, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any registration resulting therefrom, declares that: he is Managing Director of the Applicant, Fratelli Zanella S.p.A., and is authorized to execute this instrument as an officer of and on behalf of said Applicant; he believes said Applicant to be the owner of the trademark sought to be registered; to the best of his knowledge and belief, no other person, firm, corporation or association has

- 3 -

the right to use said mark in commerce, either in the identical form or in such near resemblance thereto as to be likely, when applied to the goods of such other person, to cause confusion or to cause mistake or to deceive; the facts set forth in this Application are true; all statements made of his knowledge are true; and all statements made on information and belief are believed to be true.

FRATELLI ZANELLA S.p.A.

Dated: May 21, 1987

By: 
Landino Lovison

Its: Managing Director

EXHIBIT 10

10-1-

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: ZANELLA S.p.A.

SERIAL NO.: 74/548674

FILED: July 13, 1994

MARK: ZANELLA

)
) Law Office 15
)
) Trademark
) Attorney:
Susana Miraballes

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513



ZA

RESPONSE TO OFFICE ACTION AND AMENDMENT TO APPLICATION

Office Action dated January 3, 1995 has been received and its contents carefully noted. Based on the Examining Attorney's remarks, the Applicant respectfully submits the following:

INTRODUCTION

The Examining Attorney has indicated that the mark is primarily merely a surname and has therefore refused registration of the mark on the Principal Register. In addition, the Examining Attorney has noted the informality that the identification of goods is unacceptable as too broad and has suggested an amended identification of the Applicant's goods. Further, the Examining Attorney enclosed copies of existing registrations and requested Applicant to claim ownership of the registrations if Applicant is in fact the owner of said registrations. Applicant responds as follows:

EXPLANATION AND AMENDMENT

In reply to the Examining Attorney's refusal based upon the allegation that the Applicant's "ZANELLA" Mark (hereinafter the "ZANELLA Mark" or the "Mark") is primarily merely a surname, Applicant asserts that its Mark is distinctive and a recognized Mark for wearing apparel. The primary significance of Applicant's Mark to the purchasing public is as a source identifier for fine clothing. Applicant's Mark was first used in Italy at least as early as 1961 where it became and remains today recognized as a leading Mark for high quality wearing apparel. The popularity of the ZANELLA Mark expanded throughout Europe, North and South America, and the Middle East where it similarly became and remains a well-known and recognized Mark for wearing apparel. The ZANELLA Mark's world-wide fame and recognition

EXHIBIT 10

is evidenced by its existing U.S. registrations (discussed below), as well as trademark registrations in Italy, Canada and Western Europe and pending applications for the ZANELLA Mark in Venezuela and throughout Europe. The Mark's popularity in the United States is further evidenced by the attached articles which discuss ZANELLA suits, slacks and clothing, demonstrating that ZANELLA is a recognized Mark in U.S. fashion. The attached articles from the Chicago Tribune and Women's Wear Daily further demonstrate that the primary significance of the ZANELLA Mark to the purchasing public is as a source identifier for fine women's and men's clothing. ✓

The diverse wearing apparel sold under the ZANELLA trademarks has been advertised to the purchasing public and to the trade in the United States through advertising media, including newspapers, magazines, trade publications, and the like. Goods bearing the ZANELLA Marks are sold in approximately 500 stores in the United States and approximately 2,000 stores world-wide. On an annual basis, Applicant spends over \$1,000,000 in advertising for ZANELLA products and has spent more than \$10,000,000 over the past decade. Sales of ZANELLA products have steadily increased over the years, with \$31,000,000 in sales during the past year and over \$250,000,000 in sales over the past decade. By virtue of the wide renown of the ZANELLA trademarks throughout the United States and world-wide, coupled with the growing distribution and sale of the various products distributed under the trademarks, the ZANELLA Marks are distinctive in the minds of the purchasing public, and products displaying such marks are immediately identified by the purchasing public as a source identifier for the ZANELLA trademarked products.

In further support of Applicant's assertion that its ZANELLA Mark is not primarily a surname, Applicant claims it is the owner of prior registrations on the Principal Register for the same mark for similar goods. In particular, Applicant is the owner of U.S. Trademark Registration No. 1,519,894 for ZANELLA, used in connection with men's wearing apparel, namely raincoats, mantles, jackets, shirts, blouses, waistcoats, trousers, pants, socks, stockings, ties, scarves, hats, swimwear, vests and underwear in Class 25. Applicant is also the owner of U.S. Trademark Registration No. 1,527,003 for ZANELLA & Design which is also used in connection with men's wearing apparel in Class 25. Furthermore, Affidavits of Use and Incontestability under Sections 8 & 15 of the Trademark Act of 1946, as amended, have been filed for the above ZANELLA registrations and are currently pending with the PTO. (see attached copies of Registrations and Affidavits of Use and Incontestability).

Additionally, Applicant has fiercely sought to protect its distinctive Mark in the United States against others who have attempted to benefit from the use of Applicant's Mark. (See attached copy of Complaint filed against European Fashion Warehouses, Inc. for their unauthorized use of the ZANELLA Mark).

In response to the Examining Attorney's note that the identification of the Applicant's goods is indefinite, the Applicant strikes its previous identification of goods and hereby amends its application and adopts the following identification of goods:

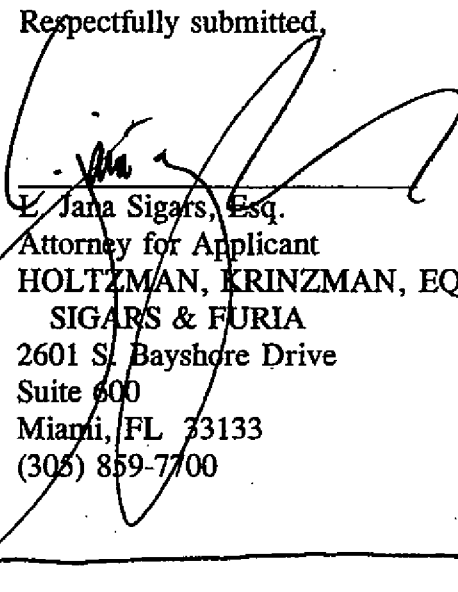
38 A1 "Women's clothing, namely, shorts, skirts, dresses, blouses, pants, jackets, coats, vests, scarves, hats, swimwear, raincoats, socks and underwear".

list 25

In reply to the Examining Attorney's request that the Applicant submit a claim of ownership of Registration Nos. 1,527,003 and 1,519,894 if the Applicant is the owner of said registrations, Applicant states, as asserted above, it is the owner of the registrations as evidenced by the attached copies of the Registrations and Affidavits of Use and Incontestability.

In view of the foregoing response and amendments, Applicant respectfully requests that this application be passed on to publication.

Respectfully submitted,



L. Jana Sigars, Esq.
Attorney for Applicant
HOLTZMAN, KRINZMAN, EQUELS,
SIGARS & FURIA
2601 S. Bayshore Drive
Suite 600
Miami, FL 33133
(305) 859-7700

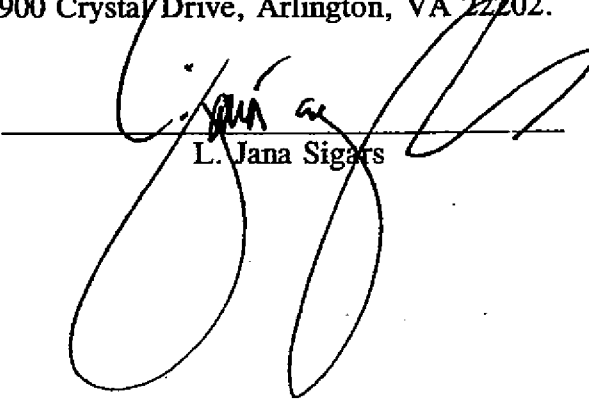
R ^{A2} APPLICANT IS THE OWNER OF US. REG'S 1527003 AND 1519894 PRIN

CERTIFICATE OF EXPRESS MAIL

Express Mail label number: IB543633486 US

Date of deposit: July 3, 1995

I hereby certify that Applicant's Response to Office Action and Amendment to Application is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202.



L. Jana Sigars

EXHIBIT 11

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office

Reg. No. 1,990,695

Registered Aug. 6, 1996

**TRADEMARK
PRINCIPAL REGISTER**

ZANELLA

**ZANELLA S.P.A. (ITALY CORPORATION)
VIA CAPOVILLA 19
CALDOGNO (VI), ITALY 36030**

**FOR: WOMEN'S CLOTHING, NAMELY
SHORTS, SKIRTS, DRESSES, BLOUSES,
PANTS, JACKETS, COATS, VESTS, SCARVES,
HATS, SWIMWEAR, RAINCOATS, SOCKS AND
UNDERWEAR, IN CLASS 25 (U.S. CLS. 22 AND
39).**

**FIRST USE 1-31-1978; IN COMMERCE
1-31-1978.**

**OWNER OF U.S. REG. NOS. 1,519,894 AND
1,527,003.**

SEC. 2(F).

SER. NO. 74-548,674, FILED 7-13-1994.

**SUSANA BEATRIZ MIRABALLES, EXAMIN-
ING ATTORNEY**

EXHIBIT 12

214
LO-15

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: ZANELLA S.p.A.)

SERIAL NO.: 74/54867/5)

FILED: July 13, 1994)

MARK: ZANELLA & Design)

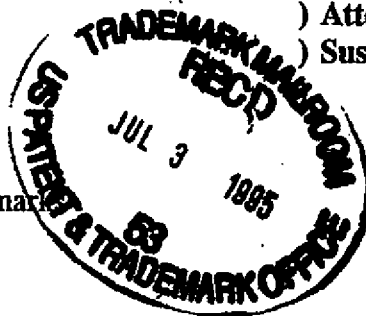
) Law Office 15

) Trademark

) Attorney:

) Susana Miraballes

Assistant Commissioner for Trademark
2900 Crystal Drive
Arlington, VA 22202-3513



RESPONSE TO OFFICE ACTION AND AMENDMENT TO APPLICATION

Office Action dated January 3, 1995 has been received and its contents carefully noted. Based on the Examining Attorney's remarks, the Applicant respectfully submits the following:

INTRODUCTION

The Examining Attorney has indicated that the mark is primarily merely a surname and has therefore refused registration of the mark on the Principal Register. In addition, the Examining Attorney has noted the informality that the identification of goods is unacceptable as too broad and has suggested an amended identification of the Applicant's goods. Further, the Examining Attorney enclosed copies of existing registrations and requested Applicant to claim ownership of the registrations if Applicant is in fact the owner of said registrations. Applicant responds as follows:

EXPLANATION AND AMENDMENT

In reply to the Examining Attorney's refusal based upon the allegation that the Applicant's "ZANELLA & Design" Mark (hereinafter the "ZANELLA Mark" or the "Mark") is primarily merely a surname, Applicant asserts that its Mark is distinctive and a recognized Mark for wearing apparel. The primary significance of Applicant's Mark to the purchasing public is as a source identifier for fine clothing. Applicant's Mark was first used in Italy at least as early as 1961 where it became and remains today recognized as a leading Mark for high quality wearing apparel. The popularity of the ZANELLA Mark expanded throughout Europe, North and South America, and the Middle East where it similarly became and remains a well-known and recognized Mark for wearing apparel. The ZANELLA Mark's world-wide fame and

recognition is evidenced by its existing U.S. registrations (discussed below), as well as trademark registrations in Italy, Canada and Western Europe and pending applications for the ZANELLA Mark in Venezuela and throughout Europe. The Mark's popularity in the United States is further evidenced by the attached articles which discuss ZANELLA suits, slacks and clothing, demonstrating that ZANELLA is a recognized Mark in U.S. fashion. The attached articles from the Chicago Tribune and Women's Wear Daily further demonstrate that the primary significance of the ZANELLA Mark to the purchasing public is as a source identifier for fine women's and men's clothing.

The diverse wearing apparel sold under the ZANELLA trademarks has been advertised to the purchasing public and to the trade in the United States through advertising media, including newspapers, magazines, trade publications, and the like. Goods bearing the ZANELLA Marks are sold in approximately 500 stores in the United States and approximately 2,000 stores world-wide. On an annual basis, Applicant spends over \$1,000,000 in advertising for ZANELLA products and has spent more than \$10,000,000 over the past decade. Sales of ZANELLA products have steadily increased over the years, with \$31,000,000 in sales during the past year and over \$250,000,000 in sales over the past decade. By virtue of the wide renown of the ZANELLA trademarks throughout the United States and world-wide, coupled with the growing distribution and sale of the various products distributed under the trademarks, the ZANELLA Marks are distinctive in the minds of the purchasing public, and products displaying such marks are immediately identified by the purchasing public as a source identifier for the ZANELLA trademarked products.

In further support of Applicant's assertion that its ZANELLA Mark is not primarily a surname, Applicant claims it is the owner of prior registrations on the Principal Register for the same mark for similar goods. In particular, Applicant is the owner of U.S. Trademark Registration No. 1,519,894 for ZANELLA, used in connection with men's wearing apparel, namely raincoats, mantles, jackets, shirts, blouses, waistcoats, trousers, pants, socks, stockings, ties, scarves, hats, swimwear, vests and underwear in Class 25. Applicant is also the owner of U.S. Trademark Registration No. 1,527,003 for ZANELLA & Design which is also used in connection with men's wearing apparel in Class 25. Furthermore, Affidavits of Use and Incontestability under Sections 8 & 15 of the Trademark Act of 1946, as amended, have been filed for the above ZANELLA registrations and are currently pending with the PTO. (see attached copies of Registrations and Affidavits of Use and Incontestability).

Additionally, Applicant has fiercely sought to protect its distinctive Mark in the United States against others who have attempted to benefit from the use of Applicant's Mark. (See attached copy of Complaint filed against European Fashion Warehouses, Inc. for their unauthorized use of the ZANELLA Mark).

In response to the Examining Attorney's note that the identification of the Applicant's goods is indefinite, the Applicant strikes its previous identification of goods and hereby amends its application and adopts the following identification of goods:

"Women's clothing, namely, shorts, skirts, dresses, blouses, pants, jackets, coats, vests, scarves, hats, swimwear, raincoats, socks and underwear".

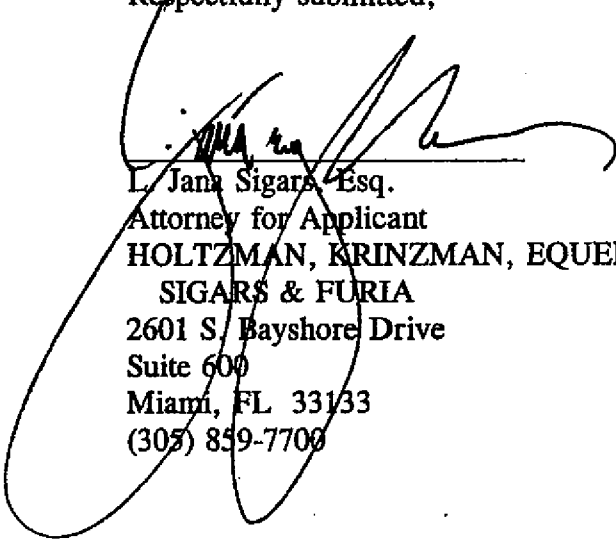
list 25

PRINT: THE APPLICANT IS THE OWNER OF U.S. REGISTRATION
NOS. 1519894 AND 1527003.

In reply to the Examining Attorney's request that the Applicant submit a claim of ownership of Registration Nos. 1,527,003 and 1,519,894 if the Applicant is the owner of said registrations, Applicant states, as asserted above, it is the owner of the registrations as evidenced by the attached copies of the Registrations and Affidavits of Use and Incontestability.

In view of the foregoing response and amendments, Applicant respectfully requests that this application be passed on to publication.

Respectfully submitted,



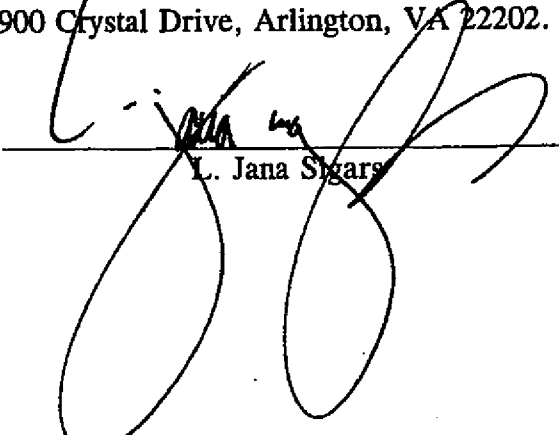
L. Jana Sigars, Esq.
Attorney for Applicant
HOLTZMAN, KRINZMAN, EQUELS,
SIGARS & FURIA
2601 S. Bayshore Drive
Suite 600
Miami, FL 33133
(305) 859-7700

CERTIFICATE OF EXPRESS MAIL

Express Mail label number: 1B543633475 US

Date of deposit: July 3, 1995

I hereby certify that Applicant's Response to Office Action and Amendment to Application is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202.



L. Jana Sigars

EXHIBIT 13

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office **Reg. No. 1,992,385**
Registered Aug. 13, 1996

**TRADEMARK
PRINCIPAL REGISTER**

Zanella

**ZANELLA S.P.A. (ITALY CORPORATION)
VIA CAPOVILLA 19
CALDOGNO (VI), ITALY 36030**

**FOR: WOMEN'S CLOTHING, NAMELY
SHORTS, SKIRTS, DRESSES, BLOUSES,
PANTS, JACKETS, COATS, VESTS, SCARVES,
HATS, SWIMWEAR, RAINCOATS, SOCKS,
AND UNDERWEAR, IN CLASS 25 (U.S. CLS. 22
AND 39).**

**FIRST USE 1-31-1978; IN COMMERCE
1-31-1978.**

**OWNER OF U.S. REG. NOS. 1,519,894 AND
1,527,003.
SEC. 2(F).**

SER. NO. 74-548,675, FILED 7-13-1994.

**SUSANA BEATRIZ MIRABALLES, EXAMIN-
ING ATTORNEY**